IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	
MOODIE, Justin C. et al.	Examiner: E. P. Leroux
Serial No.: 09/803,928	
Filed: March 13, 2001	Art Unit: 2162
For: COMMUNICATIONS SYSTEM WITH DATABASE MANAGEMENT	

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313-1450
ATTENTION: Board of Patent Appeals and Interferences

Sir:

Appellants submit this reply brief in the above-referenced application. The Examiner's Answer was mailed on June 27, 2005.

ISSUES

A. Petrovich Does Not Anticipate the Claims

In the Appeal Brief, Appellants assert that Petrovich does not anticipate claims 27-29, 31, 33-35 and 37, because Petrovich does not disclose "determining from the received signal at the portable computer device whether <u>any item</u> on the shopping list <u>is available</u>" or that "provid[es] an indication to the user of the portable computer device <u>that the item is available</u>," as recited in independent claims 27 and 33 (emphasis added). Petrovich merely indicates whether the user is on an efficient path toward a location where an item may be, not whether that item is actually available in the store.

In the Examiner's Answer, the Examiner continues to assert that Petrovich inherently shows the above features. The Examiner improperly cites to the Webster's New World College Dictionary to define inherent as "as a natural and inseparable quality, characteristic, or right" and then attempts to use this "definition" of inherency to "prove" that Petrovich inherently discloses that "any item on the shopping list [being] available in the store". See Examiner's Answer starting at page 8. The Examiner ignores the relevant case law on inherency, such as the following:

The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Petrovich never discloses determining "any item on the shopping list [being] available in the store", and the Examiner specifically admits that this language is not in Petrovich. See Examiner's Answer at page 9. The Examiner's Answer points to various excerpts from Petrovich as supposedly supporting his assetion of inherency. The Examiner refers to col. 2, lines 25-35 of Petrovich, which indicates the shopping establishment cradle accepts data from the portable terminal through the kiosk data interface and the terminal two-way data interface when the portable terminal is received in the kiosk portable terminal-receiving station, and then

downloads the data to the host computer. The Examiner speculates that it is inherent that the host computer compares the user-entered shopping list with the inventory available in the store so that when the user proceeds to the store, the shopper can be confident that the items are ready and available on the shelves in the store. However, Petrovich never discloses comparing any shopping list with inventory available in the store, and such is not "necessarily present" in Petrovich as would be required for inherency. The mere placing of an order by transferring data of the order does not disclose confirming if the ordered items are available in the store. Further, the claims require that the determination of whether an item is available be made "at the portable computer device", not at a host computer.

The Examiner then refers to col. 9, lines 9-12 of Petrovich indicating that after the order is placed, a verification query can be sent to verify the correctness and validity of an order. The Examiner speculates that verification implies that an item entered by the shopper is available for purchase. Sending a verification query to a shopper does not require checking to see if items are available in the store, but instead verifies the contents of the order. Whether or not a user would be frustrated if the ordered items were not available as asserted by the Examiner is irrelevant to a determination of inherency. A verification query simply does not require checking to see if items are available in the store, and as such, does not result in inherency.

The Examiner then refers to col. 11, lines 19-25 concerning items that can be included in the verification query, and refers to col. 12, lines 16-27 concerning confirming items on the shopping list. Again none of these disclosures require that the system of Petrovich check to see if the ordered items are available in the store, and therefore cannot result in a finding of inherency.

The Examiner also refers to col. 9, lines line 55 to col. 10, line 3 concerning confirming items on the shopping list, which discloses a hard copy of the shopping list be printed by the kiosk cradle 24 (not from the portable terminal 40) that the user can use to check off items on the hard copy with a conventional ink pen as items are picked off the shelves and scanned. The Examiner asserts that obtaining a hard copy of the shopping list anticipates determining whether any item is available in the store. The Examiner's position is wrong for two reasons. First,

printing out a copy of the shopping list does not indicate whether the items are actually available in the store. Second, even if the list did indicate the items were available (which it does not), the list is printed by the kiosk cradle 24, not by the portable terminal 40, and thus would not be a determination at the portable computer device as required by the present claims.

The Examiner further refers to col. 10 lines 25-38 and 39-59 which disclose that the optimized shopping list can be used to direct the user through the store in an efficient path, and can sense the position of the portable terminal 40, and communicate a message to the user when he deviates from the efficient path, and can give the user directions. However, directing the user to a shelf location or giving the user directions does not determine at the portable computer device whether an item is available in the store. Instead, it directs the user to a location, but does not disclose determining whether the item is available. Again, a finding of inherency would require that Petrovich necessarily includes determining at the portable computer device whether an item is available in a store, not merely that it could include such features.

The Examiner repeatedly refers to "inventory control" and comparing the list with "inventory" available in the store. This is nothing more than speculation on the part of the Examiner. The word "inventory" does not even appear in Petrovich, and the Examiner's speculation about how Petrovich could use scanned information is improper, and cannot form a basis for a finding of inherency. The fact that the system of Petrovich possibly could work this way is not sufficient for inherency.

In summary, the Examiner has failed to show that Petrovich inherently discloses "determining from the received signal at the portable computer device whether any item on the shopping list is available" or that "provid[es] an indication to the user of the portable computer device that the item is available," as recited in independent claims 27 and 33. Thus, the Examiner has failed to show the features are inherent in Petrovich.

B. **Petrovich in View of the Secondary References do Not Render the Claims Obvious**

As set forth in the Appeal Brief, Petrovich in view of the secondary references do not render obvious any of the claims, for the reasons given above, and because the secondary references do not remedy the above-noted deficiencies of Petrovich.
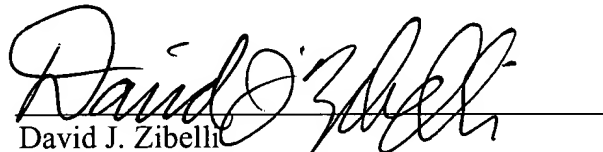
CONCLUSION

Appellants respectfully requests reversal of the rejections of claims 27-38. These claims are allowable over the cited art.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

Date: August 11, 2005

David J. Zibelli
Registration No. 36,394

KENYON & KENYON
1500 K Street, N.W.
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201